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10/510,113	10/04/2004	Yoshiaki Shibata	450100-04500	5049

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Frommer Lawrence & Haug  
745 Fifth Avenue  
New York, NY 10151

EXAMINER

MEYERS, JAMES A

ART UNIT	PAPER NUMBER
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2609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/510,113

Applicant(s)

SHIBATA ET AL.

Examiner

James A. Meyers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/10/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to the initial filing of October 4, 2004. Claims 1-11 are pending and have been considered below.

#### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "12" and "14" have both been used to designate a recording medium in Figure 1. Additionally, reference characters "17" (page 22, line 1), "47" and "51" (Figure 3) have all been used to designate a monostable multivibrator. Additionally, reference characters "19", "49" and "77" have all been used to designate a signal select switch. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "74" has been used to designate both an analog audio signal generator (in the specification, page 21, lines 6 and 23) and an analog audio signal recorder (Figure 3). Additionally, reference character "45" has been used to designate both an electronic mark text data holder (Figure 3) and an electronic mark test data holder (page 22, line 12). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

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description: record start data holder 44 (page 22, line 11). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: recording medium 12 (Figure 1). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application.

5. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract contains 183 words, thus exceeding the 150 word limit.

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The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The disclosure is objected to because of the following informalities:

7. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or

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verbose terms used in the specification are: the use of the word "edition" to mean the act of making an edit and the use of the word "ingesting" relating to portions of video scenes.

8. The Examiner notes that the specification is replete with grammatical and typographical errors including incorrect spelling and use of words, duplicate paragraphs, and incorrect placement and tense of verbs. The Examiner requests Applicant's assistance in finding and correcting these errors.

9. The examiner notes the use of acronyms (e.g. IEEE, UMIT, No., RS-232C, MPEG-2, etc.) throughout the specification without first including a description in plain text, as required.

10. Appropriate correction is required.

11. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Video Content Editing Support System and Method.

### ***Claim Objections***

12. Claim 11 is objected to because of the following informalities: a typographical error appears to be present in the claim, omitting the word "comprising" on the last line of page 53. Additionally, the Examiner notes that Applicant is using the word "edition" to mean "the act of making an edit" when it does not have that meaning. The Examiner

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believes Applicant means to use the word "editing", and will examine the claims as such. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an imaging device connected to an editor's terminal unit, does not reasonably provide enablement for a recorder which describes electronic mark data. The system in this claim consists of a single structure: "a recorder which describes electronic mark data related to the video content data in the video content data", and thus is interpreted as a single means/single step claim under MPEP 2164.08(a).

Claims 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an editor's terminal unit connected to an imaging device, does not reasonably provide enablement for an edition unit to edit the video content on the basis of the electronic mark data related to the video content data. The system in this claim consists of a single structure: "an edition unit to edit the video content on the basis of the electronic mark data related to the video content data", and thus is interpreted as a single means/single step claim under MPEP 2164.08(a).

"A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor."

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-8 and 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claims 1-8 teach a system comprising a recorder, an electronic mark list generator and an editing unit. However, the preamble of the claims states that the system includes an imaging device, an editor's terminal unit, and a network. One of ordinary skill in the art would not know which or how many components the applicant considers as part of his system. Therefore, the claims are considered indefinite. The



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claim will be examined as comprising a recorder, an electronic mark list generator and an editing unit.

17. Claim 11 teaches a method comprising the steps of describing electronic mark data, generating electronic mark list data and editing the video content data. However, the preamble of the claim states that the method includes recording captured video content, displaying video content data and connecting the imaging device and the editor's terminal unit to each other. One of ordinary skill in the art would not know which or how many steps the applicant considers as part of his method. Therefore, the claims are considered indefinite. The claim will be examined as comprising the steps of describing electronic mark data, generating electronic mark list data and editing the video content data.

18. Claim 3 recites the limitations "the header information" and "the video scenes" in the first and second lines of the claim, respectively. There is insufficient antecedent basis for this limitation in the claim. The Examiner will continue to examine the claim as dependent on Claim 1.

19. Claim 5 recites the limitation "the attribute mark data" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. The Examiner will examine the claim as dependent on Claim 4, which teaches attribute mark data.

20. Claim 6 recites the limitation "the electronic mark text data" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. The

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Examiner will examine the claim as dependent on Claim 4, which teaches electronic mark text data.

***Claim Rejections - 35 USC § 102***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukai et al. (WO 97/10673).

**Claims 1 and 11:** Fukai discloses a video content editing support system and method (page 1, 1<sup>st</sup> paragraph) comprising:

(a) a recorder to describe electronic mark data related to the video content data in the video content data (page 1, 5<sup>th</sup> paragraph onto page 2, 1<sup>st</sup> paragraph);

(b) an electronic mark list generator to generate electronic mark list data including header information on the video content data (page 1, 5<sup>th</sup> paragraph onto page 2, 1<sup>st</sup> paragraph); and

(c) an editing unit to edit the video content data on the basis of the electronic mark list data (page 1, 5<sup>th</sup> paragraph onto page 2, 1<sup>st</sup> paragraph).

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**Claim 2:** Fukai discloses a system as in claim 1, and further discloses that the recorder describes the video content data and electronic mark data on a nearly real-time basis (page 6, last paragraph).

**Claim 3:** Fukai discloses a system as in claim 1, and further discloses that the header information on the video content data is header information on the video scenes included in the video content data (page 5, last paragraph).

**Claim 4:** Fukai discloses a system as in claim 1, and further discloses that the electronic mark data includes attribute mark data being attribute information on at least the video content data, and electronic mark text in which a feature of the video content is described (page 8, 3<sup>rd</sup> paragraph).

**Claim 5:** Fukai discloses a system as in claim 4, and further discloses that the attribute mark data includes scene identifiers of video scenes in at least content video data (page 8, 3<sup>rd</sup> paragraph).

**Claim 6:** Fukai discloses a system as in claim 4, and further discloses that the electronic mark text data has described therein a feature, location of imaging or date of imaging of each video scene included in at least the video content data with text data (page 8, 3<sup>rd</sup> paragraph).

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**Claim 7:** Fukai discloses a system as in claim 1, and further discloses that the edition unit generates edition information data on the basis of the electronic mark list data and video content data (page 11, 3<sup>rd</sup> and 4<sup>th</sup> paragraphs).

**Claim 9:** Fukai discloses an imaging device comprising a recorder which describes electronic mark data related to the video content data in the video content data (page 1, 5<sup>th</sup> paragraph onto page 2, 1<sup>st</sup> paragraph).

**Claim 10:** Fukai discloses an editor's terminal unit comprising an editing unit to edit the video content data on the basis of the electronic mark data related to the video content data (page 1, 5<sup>th</sup> paragraph onto page 2, 1<sup>st</sup> paragraph).

***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukai et al. (WO 97/10673).

**Claim 8:** Fukai discloses a system as in Claim 1 above, but does not explicitly disclose that the electronic mark data is based on an input voice. However, Fukai discloses an

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audio input to the system for describing the electronic mark data (page 1, 5<sup>th</sup> paragraph onto page 2, 1<sup>st</sup> paragraph). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use any kind of audio input, including a human voice, to describe the electronic mark data. One would have been motivated to do so to allow for rapid marking of the video content data without physical input apparatus such as a mouse or a keyboard.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fukai et al. (US 2001/0031131) is entered into the record as being the national stage application and English translation of the '673 publication cited above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Meyers whose telephone number is 571-270-1690. The examiner can normally be reached on Mon-Fri (Alternate Fridays Off), 7:00 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/26/2007  
JM



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